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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

WOO, RICHARD SUKYOON

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 05/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/028,888

Applicant(s)

NOWLIN

Examiner

Richard Woo

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My

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,6-16,18-22 and 27-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2, 4, 6-16, 18-22, and 27-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1) In view of the Appeal Brief filed on February 19, 2004, PROSECUTION IS HEREBY REOPENED. The non-final action is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

2) The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

3) The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4) Claims 1-2, 4, 6-16, 18-22, and 27-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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In Claim 1, line 8; Claim 15, line 7; Claim 27, line 8; and Claim 31, line 8, respectively, the recitation of “may” renders the claim indefinite because it is not clear whether the identifier is actually used in identifying the components of the mailing unit or not.

In Claims 18 and 19, claims are deemed to be dependent on the canceled claim 17. It is not clear whether Claims 18-19 are also canceled or they are dependent on other claim(s).

Claim Rejections - 35 USC § 102

5) Claims 1-2, 4, 6-8, 10, 12, 15-16, 18-20, 27, 30-31 and 34, as far as they are definite, are rejected under 35 U.S.C. 102(b) as being anticipated by Long (EP 0,621,563).

W.R.T. Claim 1:

Long discloses a method for producing and weighing a mailing unit, comprising:
determining a weight of each of the components and electronically storing its record (Fig. 2; databases 88, 90);

printing an identifier (information to identify a person; credit card number or driver's license number) on a section of the traveling web of paper (see abstract and col. 2, line 55 – col. 3, line 4; col. 4, lines 32-40);

reading the identifier to determine the components of the mailing unit;

placing the inserts into the envelope (see Figs.); and

determining the weight of the mailing unit based on the weights of the components that are stored in the weight record (for example, col. 5, lines 43-56; col. 6, line 51 –col. 7, line 5).

W.R.T. Claim 2: Long further discloses the step of predetermining the components (see abstract; known weight of the components), and summing the weights of the components of the mailing unit using a processor prior to assembly of the mailing unit (If each component of the mail is known and which component should be inserted into the envelope, the processor is capable of summing the weights of the components, col. 5, lines 42-56);

W.R.T. Claim 4: Long further discloses the method, wherein the weight determining step includes summing the weights of the components utilized to form the mailing unit as the components as selected for inclusion in the mailing unit (see Id., particularly col. 5, lines 42-56);

W.R.T. Claim 6: Long further discloses the method, wherein the summing step includes retrieving data from the memory and using the processor (86) to summing the weight (see Id.);

W.R.T. Claim 7: Long further discloses the method, wherein the inserts are held in groups (see Fig. 1b); and selecting inserts from their respective groups and placing them onto the track (see Fig. 1b; col. 5, lines 21-28, 42-56);

W.R.T. Claim 8: Long further discloses the method including the step of placing the inserts on the track into the envelope (see Id.);

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W.R.T. Claim 10: Long further discloses the method, wherein one of the inserts comprises a charge card that is attached to a card carrier, wherein the identifier is printed on the card carrier (see Figs. 1a-2; the card must be matched with the carrier);

W.R.T. Claim 12: Long further discloses the method, wherein the inserts are selected from a group including: letters, advertisements, checks, PIN mailers, phone cards and maps (see Id.).

W.R.T. Claim 15:

Long discloses a system for producing and weighing mailing units, comprising:
a controller having a processor and a memory containing the weight of each of the components (predetermined) (see Fig. 2; also Supra Claim 1);

a printer (as controlled by the controller 25) for printing an identifier (information to identify a person; credit card number or driver's license number) on a section of the traveling web of paper (see abstract and col. 2, line 55 – col. 3, line 4; col. 4, lines 32-40);

a reader (27, 66) for reading the identifier and providing the identifier to the controller;

a movable track (see Figs. 1a-2);

a plurality of inserting locations, a plurality of inserting mechanisms (see Fig. 1b);

a moving mechanism to move the inserts from the track and into an envelope (see Id.); and

wherein the controller determines the components of the mailing unit based on the identifier (see Fig. 2; the reader 27, 66 scans the identifier) and the weight of the

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mailing unit based on the weights of the components (for example, col. 5, lines 43-56; col. 6, line 51 –col. 7, line 5).

W.R.T. Claim 16: Long further discloses the system including an external storage device (see Figs. for 88, 90);

W.R.T. Claim 18: Long further discloses the system, wherein the controller sums the weights of the components prior to assembly of the mailing unit (see Supra Claims 2-4);

W.R.T. Claim 19: Long further discloses the system, wherein the controller sums the weights of the inserts as the inserts are placed onto the track (see Id.);

W.R.T. Claim 20: Long further discloses the system, wherein the inserts are selected from a group including statements, card carriers, cards and advertising information;

W.R.T. Claim 27:

Long discloses a method for producing and weighing a mailing unit, comprising:
determining a weight of each of the components and electronically storing its record (Fig. 2; databases 88, 90);

printing under the control a processor an identifier (information to identify a person; credit card number or driver's license number) on a first one (e.g., charge card) of the components until after the first component has been provided to the system (see abstract and col. 2, line 55 – col. 3, line 4; col. 4, lines 32-40);

reading the identifier to determine the components of the mailing unit (col. 5, lines 43-56; col. 6, line 51 –col. 7, line 5);

placing the inserts into the envelope (see Figs. 1a-2); and
determining the weight of the mailing unit based on the weights of the components that are stored in the weight record (for example, col. 5, lines 43-56; col. 6, line 51 –col. 7, line 5).

W.R.T. Claim 30: Long further discloses the method including the steps of printing under the control of the processor an identifier on a second one (letter, statement or envelope besides the first component) of the components forming the mailing unit, the identifier printed on the second component based on that of the first component.

W.R.T. Claim 31:

Long discloses a system for producing and weighing mailing units, comprising:
a controller having a processor and a memory containing the weight of each of the components (predetermined) (see Fig. 2; also Supra Claim 1);

a printer (as controlled by the controller 25) for printing an identifier (information to identify a person; credit card number or driver's license number) on a section of the traveling web of paper (see abstract and col. 2, line 55 – col. 3, line 4; col. 4, lines 32-40);

a reader (27, 66) for reading the identifier and providing the identifier to the controller;

a movable track (see Figs. 1a-2);

a plurality of inserting locations, a plurality of inserting mechanisms (see Fig. 1b);

a moving mechanism to move the inserts from the track and into an envelope (see Id.); and

wherein the controller determines the components of the mailing unit based on the identifier (see Fig. 2; the reader 27, 66 scans the identifier) and the weight of the mailing unit based on the weights of the components (for example, col. 5, lines 43-56; col. 6, line 51 –col. 7, line 5).

W.R.T. Claim 34: Long further discloses the system including a second printer for printing an identifier on a second component (after reading the identifier the processor will order the second printer to print the identifier (number, barcode or other identifier) on a second component of the mailing unit.

Claim Rejections - 35 USC § 103

6) Claims 9, 11, 28-29, 32-33 and 35, as far as they are definite, are rejected under 35 U.S.C. 103(a) as being unpatentable over Long.

W.R.T. Claims 9, 11, 29 and 33:

Long discloses the invention as cited earlier, but does not expressly disclose the invention including that one of the inserts is a financial statement.

This limitation is non-functional data and does not give any patentability weight to the claims to distinguish over the prior art.

Therefore, it would have been obvious to modify Long to obtain the invention as specified in claims.

W.R.T. Claims 28, 32 and 35:

Long further discloses the invention as recited earlier, but does not expressly disclose the invention including the first component being a card carrier for insertion into the envelope, wherein a second of the components is a card for attachment to the card carrier, wherein the identifier is printed on the card carrier before having the card attached thereto, and wherein the identifier identifies a specific card for attachment to the carrier.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to modify Long to utilize the card carrier for the first component and the card for the second component because Applicant has not disclosed that the first component or second component being the card carrier is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with Long because Long discloses the invention to utilize the card as the first component and the card carrier as the second component, and it would be obvious to switch the first component with the second component.

Therefore, it would have been an obvious matter of design choice to modify Long to obtain the invention as specified in claim.

7) Claims 13-14 and 21-22, as far as they are definite, are rejected under 35 U.S.C. 103(a) as being unpatentable over Long in view of Delfer, III (US 5,264,665).

Long discloses the invention as cited earlier, but does not specifically disclose the invention having the step of organizing, sorting or classifying the mailing units based on their weight within a given group via a marking.

Delfer teaches, for a system for determining the weights of the mailing units, that the system includes a device to classify the mailing units based on their weight within a given group (col. 6, lines 41-59).

Since Delfer and Long are both from the same field of endeavor, the purpose disclosed by Delfer would have been well recognized in the pertinent field of Long.

Accordingly, it would have been obvious at the time the invention was made to a person having ordinary skill in the art, to organize, sort or classify the mailing units based on their weight within a given group by using Long's current printing means to mark those mailing units, as taught by Delfer, for the purpose of providing a computer directed system which accumulates and presents relevant data concerning mailing pieces sent and postage due.

Conclusion

8) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Woo whose telephone number is 703-308-

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7830. The examiner can normally be reached on Monday-Friday from 8:30 AM -5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703-308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0861.



Richard Woo
GAU 3629
April 30, 2004

JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600